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In re Application of	:	DECISION ON
SKRYABIN et al	:	
PCT No.: PCT/AU2004/001768	:	
Application No: 10/583,121	:	
Int. Filing Date: 17 December 2004	:	PETITION UNDER
Priority Date: 18 December 2003	:	
Attorney's Docket No.: GRIHAC P48AUS	:	
For: METHOD FOR...	:	
NANO-PARTICULATE LAYERS	:	37 CFR 1.47(a)

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 10 April 2007. The petition fee of 200.00 has been paid.

BACKGROUND

On 17 December 2004, applicants filed international application PCT/AU2004/001768, which claimed priority to an earlier application filed 18 December 2003.

On 16 June 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the Transmittal Letter.

On 19 March 2007, petitioner filed the present petition under 37 CFR 1.47(a) accompanied, *inter alia*, with a declaration in support of filing on behalf of omitted inventor Igor SKRYABIN, and an executed Declaration without the signature of Igor Lvovich SKRYABIN.

On 02 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that the current Oath or Declaration does not comply with 37 CFR 1.497(a), and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. All of the items set forth must be submitted within two months from date of this notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 10 April 2007, petitioner re-filed the present petition under 37 CFR 1.47(a) that was originally filed on 19 March 2007.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or

declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner have satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, item (2) of 37 CFR 1.47(a) has not been satisfied.

Regarding item (1), petitioner has provided the fee under 37 CFR 1.17(g).

Regarding item (2), the statements by Bujold are insufficient to support a finding that the nonsigning inventor, Dr. Skryabin refuses to sign the declaration because based on the communication dated 01 November 2006 by Dr. Skryabin there appears to be a disagreement by the parties, which has not be clarified by petitioner.

In addition, in this case Mr. Bujold has not sufficiently demonstrated that a complete copy of the application papers were presented to the non-signing inventor, Dr. Skryabin. Petitioner has not stated that the complete copy of the application papers (specification, including claims, drawings, and oath or declaration) were sent to Dr. Skryabin and that he refused to sign the required papers as stipulated under MPEP 409.03(d). The letter to Dr. Skryabin by Mr. Bujold only refers to the Oath and the Power of Attorney being for Dr. Skryabin but is silent about the patent applications (it just refers to three applications) being included in the correspondence sent to him for his review.

Accordingly, the current record does not support the premise that Dr. Skryabin's conduct constitutes refusal since he was not given until the deadline to provide the documents.

Regarding item (3), petitioner has provided a statement of the last known address of the nonsigning inventor.

Regarding item (4), petitioner has provided an executed declaration signed by Graeme Leslie EVANS on his behalf and on the behalf of the nonsigning joint inventor Igor Lvovich SKRYABIN.

Consequently, at this time it can not be concluded that Dr. SKRYABIN had refused to sign the documents based on the evidence provided and the date the petition was filed.

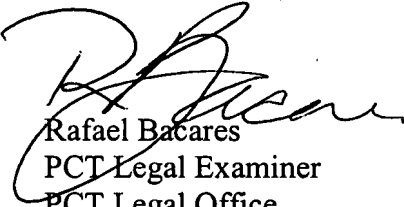
DECISION

Consequently, the petition has not met the requirements under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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